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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,345	06/07/2006	Vincent De Groot	DEGR3003/FJD	9362
23364 7590 01/13/2009 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
WACHSMAN, HAL D				
ART UNIT		PAPER NUMBER		
2857				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,345

Applicant(s)

DE GROOT ET AL.

Examiner

Hal D. Wachsmen

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. On page 5 of the specification the heading "BRIEF DESCRIPTION OF THE DRAWING" should be changed to "BRIEF DESCRIPTION OF THE DRAWINGS" as the replacement sheet for new figure 2 has been approved and there is now more than one drawing in the application. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 14, 15, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2) and Cuzzo et al. (US 2004/0129312 A1).

As per claim 14, Wischinski (Abstract, page 2, lines 9-15) discloses "using the control unit to request at intervals in time, an individual identifier of the field device". It appears though that Wischinski does not clearly disclose the remaining features of this claim. However, Ten Brink (page 2 - see all to page 3, line 1, page 10, lines 17-21, page 14, claim 1, of the translation) teaches "comparing the requested individual identifier of the field device with an identifier stored in the control unit, for preventing unauthorized tampering with the field device based on the unauthorized replacement or change of hardware, or software, or even just parts thereof in the field device" and the case of a change in the requested individual identifier. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Ten Brink to the invention of Wischinski as specified above because as taught by Ten Brink (page 2, last 2 lines, to the top of page 3 of the translation) it would open the possibility of preventing unauthorized competitors, etc. from being able to connect to the corresponding systems. It appears though that the above combination of references still does not clearly teach the producing of an alarm or warning for the case of a change in the requested individual identifier. However, as the case of a change in the requested individual identifier (as taught by Ten Brink as shown above) is indicative of unauthorized tampering with the field device, Cuzzo et al. (see at least abstract) teach the production of an alarm or warning for tampering of a field device. It would therefore have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Cuzzo et al. to the inventions of Wischinski and Ten Brink as specified above because as taught by Cuzzo

et al. (paragraph 0006) then a violation of a water system protection device's integrity could be detected and the appropriate law enforcement authorities, such as police, can be notified at the onset of a tampering event.

As per claim 15, Wishhinski (see abstract) discloses the individual identifier of the field device and with respect to the individual identifier being a serial number, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that serial numbers were typically used for the identification of manufactured products, machines, etc.

As per claim 21, it would have been obvious to person of ordinary skill in the art at the time the invention was made that maintenance work on the field device could result in the accidental triggering of alarms as it could be interpreted as tampering occurring with the field device.

As per claim 25, Wischinski (page 4, lines 5-7, 15-25) discloses communication over the Internet including the use of a browser which could be used for sending alarms or warnings.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2) and Cuzzo et al. (US 2004/0129312 A1) as applied to claim 14 above, and further in view of Jurisch et al. (7,072,987).

As per claim 16, Wischinski (Abstract, page 5, lines 26-30) discloses the individual identifier in the device firmware of the field device but does not clearly disclose the use of a key for this. However, Jurisch et al. (col. 9 lines 20, 21, 35-38)

teach this excepted feature. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Jurisch et al. to the inventions of Wischinski, Ten Brink and Cuzzo et al. as specified above because as taught by Jurisch et al. (col. 9 lines 15, 16) it would be one measure that can be used to substantially prevent abusive actions when operating the field device.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2) , Cuzzo et al. (US 2004/0129312 A1) and Jurisch et al. (7,072,987) as applied to claim 16 above, and further in view of Aisenberg et al. (6,209,090).

As per claim 17, Aisenberg et al. (Abstract, figure 5 – see blocks 506, 508) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Aisenberg et al. to the inventions of Wischinski, Ten Brink, Cuzzo et al. and Jurisch et al. as specified above because as taught by Aisenberg et al. (Abstract, col. 2 lines 62-65) it would enable the verification of the authenticity of the data being received.

6. Claims 18 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2) and Cuzzo et al. (US 2004/0129312 A1) as applied to claim 14 above, and further in view of Havekost et al. (6,774,786).

As per claim 18, Havekost et al. (Abstract (block 66), figures 5-7 (see especially days and times in these figures) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made

to apply the techniques of Havekost et al. to the inventions of Wischinski, Ten Brink and Cuzzo et al. as specified above because it would provide a history of an alarm condition pointing out with what device and at what day and time a problem occurred in the control system.

As per claim 22, Havekost et al. (see at least abstract) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Havekost et al. to the inventions of Wischinski, Ten Brink and Cuzzo et al. as specified above because as taught by Havekost et al. (Abstract) the display and interface tool may be used to filter alarms that are displayed according to any number of categories, including the category of the alarm, the priority of the alarm, the status of the alarm, etc. so as to alternatively segregate or combine the tasks typically associated with operator, maintenance and engineer personnel.

As per claim 23, Havekost et al. (col. 15, line 67, col. 16, lines 1-3) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Havekost et al. to the inventions of Wischinski, Ten Brink and Cuzzo et al. as specified above because as taught by Havekost et al. (Abstract) the display and interface tool may be used to filter alarms that are displayed according to any number of categories, including the category of the alarm, the priority of the alarm, the status of the alarm, etc. so as to alternatively segregate or combine the tasks typically associated with operator, maintenance and engineer personnel.

As per claim 24, Havekost et al. (see at least abstract) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Havekost et al. to the inventions of Wischinski, Ten Brink and Cuzzo et al. as specified above because as taught by Havekost et al. (Abstract) the display and interface tool may be used to filter alarms that are displayed according to any number of categories, including the category of the alarm, the priority of the alarm, the status of the alarm, etc. so as to alternatively segregate or combine the tasks typically associated with operator, maintenance and engineer personnel.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2), Cuzzo et al. (US 2004/0129312 A1) Havekost et al. (6,774,786) as applied to claim 18 above, and further in view of the Applicant's Admissions of the prior art.

As per claim 19, the Applicant's Admissions of the prior art (page 3, lines 9-12 of the specification) states that besides intrusions from outside of the company, likewise dangerous are unauthorized intrusions from within a company. In the case of company-internal intrusions, e.g. parameters can be changed in the field devices, or the entire control strategy can be changed. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the Applicant's Admissions of the prior art to the inventions of Wischinski, Ten Brink, Cuzzo et al. and Havekost et al. to store in the database when a change is detected in the requested individual identifier, because such a change could be indicative of an unauthorized

intrusion which could lead to undesired changes in the production process (Applicant's Admissions of the prior art, page 3, line 13, of the specification).

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Havekost et al. (6,774,786).

As per claim 26, Wischinski (Abstract, page 2, lines 9-15) discloses "directing a query by the control unit to the field device in intervals of time, the query requires an answer from the field device". It appears though that Wischinski does not clearly disclose the remaining step of this claim. However, Havekost et al. (Abstract (block 66), figures 5-7 (see days with times), col. 10 lines 23-29, col. 14 line 67, col. 15 lines 1-4, 18-21, 38-41) teach "in case no answer comes from the field device, such fact is stored in a database along with a corresponding time stamp". It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Havekost et al. to the invention of Wischinski as specified above because as taught by Havekost et al. (col. 3 lines 19-23) in the previous art there has been few if any display applications for displaying non-process alarms, such as alarms generated by the field devices or controllers indicating some problem with the hardware associated with those devices has occurred.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2), Cuzzo et al. (US 2004/0129312 A1) and Havekost et al. (6,774,786) as applied to claim 23 above, and further in view of Alexander, III et al. (US 2002/0080938 A1).

As per claim 27, Alexander, III et al. (paragraph 0040) teach the electronic form being email. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Alexander, III et al. to the inventions of Wischinski, Ten Brink, Cuzzo et al. and Havekost et al. as specified above because as taught by Alexander, III et al. (paragraph 0039) monitoring services for monitored systems were available, and traditionally may include page alert or e-mail capabilities.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wischinski (WO 01/90829 A3) in view of Ten Brink (see translation of WO 01/31407 A2) and Cuzzo et al. (US 2004/0129312 A1) as applied to claim 25 above, and further in view of Alexander, III et al. (US 2002/0080938 A1).

As per claim 28, Alexander, III et al. (paragraphs 0034, 0052) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Alexander, III et al. to the inventions of Wischinski, Ten Brink, and Cuzzo et al. as specified above because it would enable via the Internet for multiple personnel to retrieve the web page containing the information on the alarm(s) or warning(s) that have occurred.

11. Applicant's arguments filed 10-23-08 have been fully considered but they are not persuasive. On page 7 of the reply filed 10-23-08, the Applicant argues that "Ten Brink intends to prevent unauthorized competitors from being able to connect their field devices in an automation system if the field devices do not belong to the SIMATIC series." However, with respect to the underlined above, the Applicant is arguing an

unclaimed merit or distinction. On this same page the Applicant also argues that "Ten Brink does not disclose a method which makes it possible to recognize that tampering of a field device which was originally properly installed in the automation system has occurred." However, with respect to the underlined above, the Applicant is arguing an unclaimed merit or distinction. Also, as other references in addition to the Ten Brink reference were applied the following is respectfully noted:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, it is respectfully noted that no arguments were presented with respect to the Wischinski, Cuzzo et al., Jurisch et al., Aisenberg et al., Havekost et al. and Alexander, III et al. references and the features of the claims to which these references were applied (see 37 C.F.R. 1.111).

12. No claims are allowed.

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D. Wachsman whose telephone number is 571-272-2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on 571-272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hal D Wachsman/
Primary Examiner
Art Unit 2857

January 7, 2009